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DUKE W. YEE YEE & ASSOCIATES, P.C. P.O. BOX 802333 DALLAS, TX 75380				
EXAMINER				
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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* TOUFIC BOUBEZ, STEPHEN L. BURBECK,  
JAMES B. CASLER, STEPHEN G. GRAHAM, and  
MARYANN HONDO

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Appeal 2007-3758  
Application 09/753,964  
Technology Center 3600

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Decided: September 17, 2008

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Before WILLIAM F. PATE, III, ANTON W. FETTING, and DAVID B.  
WALKER, *Administrative Patent Judges*.

WALKER, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. §§ 6(b) and 134(a) (2002) from the final rejection of claims 1-30. We reverse.

Representative claim 1 reads as follows:

1. A method in a data processing system of verifying a categorization of a service in a taxonomy, comprising:

receiving a registration request at the data processing system, the registration request including a service description and an identification of a category within the taxonomy in which the service is to be registered;

applying one or more canonical service description tests to the service description to determine if the service description should be registered in the category; and

registering the service description in the identified category using the data processing system if a result of applying the one or more canonical service description tests is that the service description should be registered in the identified category.

The reference set forth below is relied upon as evidence in support of the rejection:

Poon

US 2002/0062265 A1

May 23, 2002

Claims 1-30 stand rejected under 35 U.S.C. § 102(e) as anticipated by Poon. “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 827 (1987).

Each of the rejected claims requires “applying one or more canonical service description tests to the service description to determine if the service description should be registered in the category.” The Specification describes the use of canonical service descriptions (CSDs) that permit an automatic search of the categories in a taxonomy by searching for a matching CSD, i.e., a CSD that matches a requested CSD or provides

minimum requirements corresponding to requirements of a search query. Such a search does not require input from a human user at runtime because each service categorized into a particular category is guaranteed to implement at least the functionality and APIs designated by the CSD of that category (Specification 13:12-19).

The Examiner found that Poon teaches the required test by testing whether a subcategory has related subcategories, and if it does not, the user has the option to register the subcategory (Answer 5, citing Poon 50:[0029]). According to the Appellants,

Poon fails to teach applying one or more canonical service description tests to the service description to determine if the service description should be registered in the category. The server of Poon merely determines if there are related subcategories associated with the category selection received from the user. Nowhere in Poon is a test applied to a service description to determine if the service description should be registered in the category as there is no service description received from the client in the Poon system.

(Br. 13). The Appellants argue that determining if a category has related subcategories is not equivalent to applying canonical service description tests to the service description to determine if the service description should be registered in the category (*Id.*).

We agree with the Appellants. Poon does not teach any sort of test that applies a CSD to determine whether the service description should be registered in the category as required by each of the independent claims. Because each of the appealed claims includes the disputed claim limitation,

the Appellants have shown that the Examiner erred in rejecting claims 1-30 as anticipated by Poon.

The decision of the Examiner is reversed.

REVERSED

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